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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/698,115 10/30/00 HORIUCHI

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005514 MM91/0412  
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EXAMINER

THOMPSON, T

ART UNIT

PAPER NUMBER

2873

DATE MAILED:

04/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	<b>Application No.</b> 09/698,115	<b>Applicant(s)</b> HORIUCHI, AKIHISA	
	<b>Examiner</b> Timothy J Thompson	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-20 is/are allowed.
- 6) ☒ Claim(s) 1-11, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 24 and 26-34 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 21-32 been renumbered 23-34.

### *Double Patenting*

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 6,166,864 (Horiuchi).

This is a double patenting rejection.

Regarding claim 1, Horiuchi discloses A zoom lens comprising, in order from an object side to an image side, a first lens unit of positive refractive power, a second lens unit of negative refractive power, a third lens unit of positive

refractive power and a fourth lens unit of positive refractive power, zooming from a wide-angle end to a telephoto end being effected by moving said second lens unit toward the image side, and shifting of an image plane due to zooming being compensated for by moving said fourth lens unit, wherein said second lens unit consists of four single lenses including three negative lenses and one positive lens, and the third lens unit has at least one positive lens both surfaces of which are aspherical(claim 1).

Regarding claim 2, Horiuchi said second lens unit consists of, in order from the object side to the image side, a negative first lens having a concave surface of larger curvature facing the image side than that of an opposite surface thereof, a bi-concave negative second lens, a positive third lens having a convex surface of larger curvature facing the object side than that of an opposite surface thereof and a bi-concave negative fourth lens(claim 2).

Regarding claim 3, Horiuchi discloses a zoom lens satisfying  $.24 < |f_2/f_A| < 0.33$ (claim 3).

Regarding claim 4, Horiuchi discloses a zoom lens satisfying  $36 < v_n < 65$  and  $20 < v_p < 35$ (claim 4).

Regarding claim 5, Horiuchi discloses a zoom lens satisfying  $1.70 < N_n < 1.95$ (claim 5).

Regarding claim 6, Horiuchi discloses a zoom lens satisfying  $0.82 < |R_{22}/f_2| < 1.07$ (claim 6).

Regarding claim 7, Horiuchi discloses a zoom lens satisfying  $1.66 < |R_{24}/R_{25}| < 4.0$ (claim 7).

Regarding claim 8, Horiuchi discloses a zoom lens satisfying  $1.00 < |R26/R27| < 1.46$ (claim 8).

Regarding claim 9, Horiuchi discloses focusing is performed by moving the fourth lens unit(claim 9).

Regarding claim 10, Horiuchi discloses a zoom lens satisfying  $0.86 < |F3/Fa| < 1.09$ (claim 10).

Regarding claim 11, Horiuchi discloses a zoom lens satisfying  $0.40 < B4T < 0.55$ (claim 11).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura(U.S. Patent No. 5,671,062).

Regarding claim 23, Nakamura discloses a first lens unit of positive power(fig 1, 1), a second lens unit of negative power which moves during zooming(fig 1, 2), a third lens unit of positive power(fig 1, 3), a fourth lens unit of negative power which moves during zooming(fig 1, 4), the third lens unit has a positive lens, both surfaces which are aspherical(example 1, r10-r11).

Regarding claim 25, Nakamura discloses  $|F3/FA|$  is equal to .9934.

***Allowable Subject Matter***

Claims 24, 26-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 12-20 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art taken either singularity or in combination fails to anticipate or fairly suggest the limitations of the independent claim, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claim 12, the limitation include, a first lens unit of positive refractive power, a second lens of negative refractive power, a third lens of positive refractive power, a fourth lens of positive refractive power, the second lens unit moves toward the image side during zooming, the fourth lens unit is moved during zooming, the second lens unit includes four separate lenses including three negative lenses and a positive lens, at least one of the four single lenses is an aspherical lens Therefore claims 12-20 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Thompson whose telephone number is (703) 305-0881. If the examiner can not be reached his supervisor, Georgia Epps, can be reached on (703) 308-4883.

T.J.T.

04/05/01

A handwritten signature in cursive script, appearing to read "Georgia Epps", written in black ink.

**Georgia Epps  
Supervisory Patent Examiner  
Technology Center 2800**